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EXAMINER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 63

Application Number: 09/315,796

Filing Date: may 20, 1999

Appellant(s): Davis et al.

Sanford Warren
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed September 3, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the Brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the Brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the Brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after Final Rejection contained in the Brief is incorrect.

The amendment after Final Rejection filed on September 3, 2002 has been entered. Although the Brief identifies the particular amended claims, all of the new claims 42 - 151 will be treated as amended subsequent to the Final Rejection since they have been resubmitted with this amendment.

(5) Summary of Invention

The summary of invention contained in the Brief is correct.

(6) Issues

The appellant's statement of the issues in the Brief is substantially correct. The changes are as follows:

First, certain claims corresponding to the issues have changed due to Appellant's amendment of September 3, 2002 correcting and/or changing claim dependencies. Note the corrected groupings of claims in the Grounds of Rejection below. These changes in claim dependencies do not affect the substantive rejections.

Issue 17 is moot due to the amendment filed September 3, 2002 changing the dependency of claims 137 and 151.

Issue 26 is moot as the 35 U.S.C. 102(a) rejection over Hartung et al. (EP 620,115) has been dropped.

Issue 31 is moot as the 35 U.S.C. 102(b) rejection over MAN Roland (G 93 05 552.8) has been dropped.

Issue 32 is moot due to the amendment filed September 3, 2002 correcting the objections under C.F.R. 1.75(a).

(7) *Grouping of Claims*

The rejections of the claims stand or fall together because appellant's Brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

A substantially correct copy of appealed claims 19, 20, 22, 29, and 34 appear on pages 44 - 45 of the Appendix to the appellant's Brief. The minor errors are as follows:

In claim 19 line 1: --at least one of the-- has been inserted after "wherein", "are" has been replaced with --is--, and "inks" has been replaced with --ink--.

In claim 20 line 2: --colored-- has been inserted before "flexographic".

In claim 22 line 1: --colored-- has been inserted before "flexographic" and --lithographic-- has been inserted before "colored".

In claim 29 penultimate line: "on top of" has been replaced with --over--.

In claim 34 line 5: "over" has been replaced with --on top of--.

A clean copy of claims 19, 20, 22, 29, and 34 (having bracketing and underlining with respect to the original patented claims) can be found in the **Appendix** attached hereto.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

<u>NUMBER</u>	<u>NAME</u>	<u>DATE</u>
G 93 05 552.8	MAN Roland	7/1993

<u>NUMBER</u>	<u>NAME</u>	<u>DATE</u>
	Pantone	1990
	Offsetpraxis	3/1993
US 4,841,903	Bird	6/1989
US 4,188,883	Schone et al.	2/1980
US 4,308,796	Satterwhite	1/1982
US 5,079,044	Schumacher et al.	1/1992
US 4,109,572	Roulleau	8/1978
US 5,638,752	Hartung et al.	6/1997

(10) New Prior Art

No new prior art has been applied in this Examiner's Answer.

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1) Claims 42 - 87, 94 - 96, 100 - 102, 109, 119 - 123, 125, 127 - 137, 139, and 141 - 151 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is addressed below in the 35 U.S.C. 112, first paragraph, rejection.

2) Claims 42 - 87, 94 - 96, 100 - 102, 109, 119 - 123, 125, 127 - 137, 139, and 141 - 151 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

First, there is no adequate support in the disclosure for the substrate being printed on "both sides", "the opposite side", "the reverse side", or "either side" as is now claimed. While the Description of the Related Art in column 2 lines 54 - 58 of the patent discloses that many sheetfed printing presses can print on

both sides, i.e. perfector printing, there is no specific disclosure with respect to applicant's method or apparatus in the Detailed Description of the Present Invention that the substrate is perfector printed. While the Declaration filed Sept. 19, 2001 has been carefully considered there is no objective evidence that the term "over" may unequivocally mean printing "on top of" or on the "opposite side" or that a "continuous in-line process" necessarily implies perfector printing. There is no possible way that one of ordinary skill in the art could identify the instances in the disclosure when "over" means "on top of" an already printed ink and when "over" means on the "opposite side" of the substrate.

Appellant has cited case law to persuasively argue that only the claims of the Gebrauchsmuster to MAN Roland is prior art and the not the entire disclosure thereof since only the claims are deemed to be "published". Max Daetwyler Corp. et al. v. Input Graphics, Inc., 583 F.Supp. 446, 455, 222, USPQ 150 (E.D. Pa. 1984) and In re Tenney, 45 C.C.P.A. 894, 254 F2d 619, 623-627, 117 USPQ 619 (C.C.P.A. 1958). See Paper No. 31, Fifth Supplemental Declaration filed December 8, 2000.

3) Claims 6 - 8, 38, 49, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland (G 93 05 552.8) in view of Pantone and Offsetpraxis. Claim 6 sets forth an apparatus for combining flexographic printing and lithographic printing wherein the flexographic printing station prints an aqueous based vehicle image having suspended metallic particles therein and then transferring the substrate to a lithographic station to print additional colored ink images. MAN Roland discloses a multicolored offset (i.e. lithographic) printing process having lithographic stations (1-5) and an upstream lacquering station configured as a flexographic station (6). See all of the claims of MAN Roland, in particular, claims 1 and 6. Pantone teaches the desirability of printing/coating inks having suspended metallic particles upstream of the other colors since the metallic inks are opaque and would thus block sight of any previously printed colors. Note, in particular, the paragraph headed "Color Sequence for MIPP". Offsetpraxis discloses the conventionality of a combined flexographic and lithographic printing process wherein the aqueous based inks having suspended metallic particles are printed by flexography and the remaining colors are printed by lithography. Note that Offsetpraxis specifically teaches the desirability of applying the metallic ink by

flexography as significantly more ink can be applied. See the entire document of Offsetpraxis, in particular, the middle column of page 2 of the translation and the third column of page 3 of the translation. It would have been obvious to one of ordinary skill in the art to utilize the apparatus and method of MAN Roland to print an aqueous based metallic ink at an upstream flexographic station in view of Pantone and Offsetpraxis so as to achieve the necessary opacity of the metallic ink and to print the colored inks at a lithographic station downstream from the flexographic station so that the colored inks are not obscured by the opaque metallic ink. With respect to claim 49 the alternative limitation "or on the opposite side" does not positively recite actually printing on the opposite side of the substrate. With respect to the dependent claims it would have been obvious to one of ordinary skill in the art through routine experimentation to use either uniform or non-uniform sized metal particles to achieve the desired metallic effect.

4) Claims 9 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Pantone and Offsetpraxis as applied to the claims above, and further in view of Bird (US 4,841,903). Bird teaches the conventionality of an adapted flexographic unit (12 or 13) wherein the flexographic (i.e. relief) plate (20) is mounted on a plate cylinder which contacts a blanket cylinder (23). See the entire disclosure of Bird, in particular, column 5 lines 13 - 44 and column 6 lines 6 - 20. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Pantone and Offsetpraxis, with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to selectively and easily utilize the unit as a flexographic or lithographic unit. Note the anilox roller in claim 2 of MAN Roland.

5) Claims 42, 43, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Pantone and Offsetpraxis as applied to claims 6 - 8, 38, 49, and 51 above, and further in view of Schone et al. (US 4,188,883). Schone et al. teach the conventionality of perfecting printing. See column 1 lines 11 - 32 and column 5 lines 56 - 64 of Shone et al., for example. It would have been obvious

to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Pantone and Offsetpraxis, with perfector printing in view of Schone et al. so as to print both sides of the substrate in one pass.

6) Claims 10, 29, and 31 - 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite (US 4,308,796). Note claim 4 of MAN Roland which recites that the flexographic printing station has a "relief form", i.e. a flexographic plate having portions in relief with respect to other portions. In other words some type of image. However, Satterwhite teaches a flexographic unit for either coating or printing a flexographic image. See the Abstract and column 2 line 40 through column 3 line 10 of Satterwhite. It would have been obvious to one of ordinary skill in the art to provide the apparatus and process disclosed by MAN Roland with the capability of printing a flexographic colored image in view of Satterwhite to achieve multicolor printing with the flexographic printing unit. With respect to claim 31 MAN Roland teaches a downstream lacquering (i.e. coating) station (7) in claim 3. With respect to claims 32 and 33 both waterless (dry lithography) and solvent based inks (wet lithography) are notoriously conventional in the art.

7) Claims 11, 30, and 60 - 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite as applied to the claims above, and further in view of Bird ('903). Bird teaches the conventionality of an adapted flexographic unit (note the comments above) and interstation dryers (25, 25a). See column 3 lines 12 - 25, column 5 lines 13 - 44, and the paragraph bridging columns 6 and 7 of Bird. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Satterwhite, with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to easily and selectively utilize the unit as a flexographic or lithographic unit and with interstation dryers in view of Bird so as to dry the images before subsequent printing and/or coating to eliminate smearing of the previously printed inks. Note again that MAN Roland discloses an anilox roller

in claim 2. With respect to claims 62, 64, and 65 waterless inks and halftone printing plates are notoriously conventional in the art.

8) Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite and Bird as applied to claims 11, 30, and 60 - 66 above, and further in view of Schumacher et al. (US 5,079,044). Schumacher et al. teach the conventionality of printing an encapsulated essence. See column 1 lines 29 - 31 of Schumacher et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of MAN Roland, as modified by Satterwhite and Bird, with the step of printing an encapsulated essence in view of Schumacher et al. to obtain a "scratch-and-sniff" printed substrate.

9) Claims 68 - 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite and Bird as applied to claims 11, 30, and 60 - 66 above, and further in view of Pantone and Offsetpraxis. Pantone and Offsetpraxis have been addressed above. It would have been obvious to one of ordinary skill in the art to utilize the apparatus and method of MAN Roland, as modified by Satterwhite and Bird, to print aqueous based metallic inks in view of Pantone and Offsetpraxis to achieve a superior metallic image in combination with lithographically printed colored inks.

10) Claims 34 - 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite as applied to claims 10, 29, and 31 - 33 above, and further in view of Schumacher et al. (US 5,079,044). Schumacher et al. teach the conventionality of printing an encapsulate essence. See column 1 lines 29 - 31 of Schumacher et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of MAN Roland, as modified by Satterwhite, with the step of printing an encapsulated essence in view of Schumacher et al. to obtain a "scratch-and-sniff" printed substrate. With respect to claim 36 UV curing is notoriously conventional in the art.

11) Claims 42, 43, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite as applied to claims 10, 29, and 31 - 33 above, and further in view of Schone et al. Schone et al. has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Satterwhite, with perfector printing in view of Schone et al. so as to print both sides of the substrate in one pass.

12) Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Satterwhite and Schone et al. as applied to claims 42, 43, and 53 above, and further in view of Bird. Bird has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Satterwhite and Schone et al., with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to easily and selectively utilize the unit as a flexographic or lithographic unit.

13) Claims 15 - 23, 37, 44 - 48, 55, 88 - 93, 97 - 99, 103 - 108, 110 - 118, 124, 126 - 130, 138, and 140 - 144 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird (903). MAN Roland has been addressed above. Note the anilox roller in claim 2 of MAN Roland for applying the flexographic ink. Bird teaches the conventionality of an adapted flexographic unit (11 or 12) comprising a flexographic plate (20) mounted on a plate cylinder (19), a blanket cylinder (23), an impression cylinder (24), flexographic ink providing means (21), and interstation dryers (25, 25a). See column 3 lines 12 - 25, column 5 lines 13 - 44, and the paragraph bridging columns 6 and 7 of Bird. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to easily and selectively utilize the unit as a flexographic or lithographic unit. With respect to the dependent claims, halftone and solid printing, waterless inks, sheet fed and web fed presses are conventional in the art. With respect to claims

88, 90, 92, 98, 107, 117, 129, , and 143 Bird teaches a retractable flexographic coater unit (14) so as to permit selective use of the unit as either a spot or continuous coater. See column 6 lines 26 - 58 of Bird.

14) Claim 24, 137, and 151 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird as applied to the claims above, and further in view of Schumacher et al. Schumacher et al. has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the method of MAN Roland, as modified by Bird, with the step of printing an encapsulated essence in view of Schumacher et al. to obtain a "scratch-and-sniff" printed substrate.

15) Claims 25 - 28, 131 - 134, and 145 - 148 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird as applied to claims 15 - 23, 37, 44 - 48, 55, 88 - 93, 97 - 99, 103 - 108, 114 - 118, 124, 126 - 130, 138, and 140 - 144 above, and further in view of Pantone and Offsetpraxis. Pantone and Offsetpraxis have been addressed above. It would have been obvious to one of ordinary skill in the art to utilize the apparatus and method of MAN Roland, as modified by Bird, to print aqueous based metallic inks in view of Pantone and Offsetpraxis for the reasons stated above.

16) Claims 56, 57, 135, 136, 149, and 150 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird as applied to claims 15 - 23, 37, 44 - 48, 55, 88 - 93, 97 - 99, 103 - 108, 114 - 118, 124, 126 - 130, 138, and 140 - 144 above, and further in view of Roulleau (US 4,109,572). Roulleau teaches printing an opaque white ink by flexography. See column 3 lines 61 - 68 of Roulleau. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Bird, with the step of printing with an opaque white ink in view of Roulleau so as to provide sufficient contrast for subsequently printed colors.

18) Claims 42, 43, 80, 81, 94 - 96, 100 - 102, 109, 119 - 123, 125, 127 - 130, 139, and 141 - 144 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird as applied to claims 15 - 23, 37, 44 - 48, 55, 88 - 93, 97 - 99, 103 - 108, 114 - 118, 124, 126 - 130, 138, and 140 - 144

above, and further in view of Schone et al. Each of MAN Roland, Bird, and Schone et al. have been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Bird, with perfector printing in view of Schone et al. so as to print both sides of the substrate in one pass.

19) Claims 131 - 134 and 145 - 148 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird and Schone et al. as applied to claims 42, 43, 80, 81, 94 - 96, 100 - 102, 109, 119 - 123, 125, 127 - 130, 139, and 141 - 144 above, and further in view of Pantone and Offsetpraxis. Pantone and Offsetpraxis have been addressed above. It would have been obvious to one of ordinary skill in the art to utilize the apparatus and method of MAN Roland, as modified by Bird and Schone et al., to print aqueous based metallic inks in view of Pantone and Offsetpraxis to achieve a superior metallic image.

20) Claims 135, 136, 149, and 150 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird and Schone et al. as applied to claims 42, 43, 80, 81, 94 - 96, 100 - 102, 109, 119 - 123, 125, 127 - 130, 139, and 141 - 144 above, and further in view of Roulleau. Roulleau has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Bird and Schone et al., with the step of printing with an opaque white ink in view of Roulleau so as to provide sufficient contrast for subsequently printed colors.

21) Claims 137 and 151 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Bird and Schone et al. as applied to claims 42, 43, 80, 81, 94 - 96, 100 - 102, 109, 119 - 123, 125, 127 - 130, 139, and 141 - 144 above, and further in view of Schumacher et al. Schumacher et al. has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the method of MAN Roland, as modified by Bird and Schone et al., with the step of printing an encapsulated essence in view of Schumacher et al. to obtain a "scratch-and-sniff" printed substrate.

22) Claims 72, 86, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Schone et al. Both MAN Roland and Schone et al. have been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland with perfector printing in view of Schone et al. so as to print both sides of the substrate in one pass.

23) Claims 73 - 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Schone et al. as applied to claims 72, 86, and 87 above, and further in view of Bird. Bird has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of MAN Roland, as modified by Schone et al., with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to easily and selectively utilize the unit as a flexographic or lithographic unit.

24) Claims 77 - 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over MAN Roland in view of Schone et al. as applied to claims 72, 86, and 87 above, and further in view of Schumacher et al. Schumacher et al. has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the method of MAN Roland, as modified by Schone et al., with the step of printing an encapsulated essence in view of Schumacher et al. to obtain a "scratch-and-sniff" printed substrate. With respect to claim 79 UV curing is notoriously conventional in the art.

25) Claims 6, 10, 29, 31, 38, 44 - 46, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Hartung et al. (US 5,638,752). Hartung et al. teach the apparatus and method as recited. See the entire disclosure of Hartung et al., in particular, column 2 lines 12 - 22 and 38 - 50 and column 5 line 56 through column 6 line 10.

27) Claims 7, 8, 32, 33, 47 - 49, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. ('752). Hartung et al. do not specifically disclose that the metallic particles are uniform or non-uniform, the lithographic inks are waterless or solvent based, or whether the substrate is a sheet or

a web. However, to provide uniform or non-uniform sized particles would have been obvious to one of ordinary skill in the art through routine experimentation to achieve the desired metallic look on the printed substrate. Furthermore, both waterless (dry lithography) and solvent based (wet lithography) inks are notoriously conventional in the art.

28) Claims 9, 11, 15 - 23, 25 - 28, 30, 37, 52, 55 - 57, 60 - 66, 68 - 71, 88 - 90, 91 - 93, 97 - 99, 103 - 108, 110 - 118, 124, 126 - 134, 138, and 140 - 148 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. ('752) in view of Bird. Bird has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of Hartung et al. with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to easily and selectively utilize the unit as a flexographic or lithographic unit. With respect to the dependent claims note the comments above.

29) Claims 50, 53, 72, 81, and 85 - 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. ('752) in view of Schone et al. Schone et al. has been addressed above. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of Hartung et al. with perfecter printing in view of Schone et al. so as to print both sides of the substrate in one pass.

30) Claims 54, 73 - 76, 80, 94 - 96, 100 - 102, 109, 119 - 123, 125, 127 - 134, 139, and 142 - 148 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. ('752) in view of Bird and Schone et al. It would have been obvious to one of ordinary skill in the art to provide the apparatus and method of Hartung et al. with a plate cylinder mounted flexographic plate and blanket cylinder in view of Bird so as to selectively utilize the unit as a flexographic or lithographic unit and with perfecter printing in view of Schone et al. so as to print both sides of the substrate in one pass.

The above rejections over Hartung et al. ('752) have been made as no objective evidence has been provided to antedate the filing date of Hartung et al. ('752).

Claims 1 - 5, 12 - 14, and 39 - 41 are allowed.

Claims 58, 59, and 82 - 84 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, first paragraph, set forth in this Office action.

(12) *New Ground of Rejection*

This Examiner's Answer does not contain any new ground of rejection.

(13) *Response to Argument*

Issues 1 & 2

First, the fact that perfector printing is known in the art does not justify appellant's substantial additions to the claimed invention of perfector printing in the specific manner recited. Known processes of the prior art are not automatically read into the disclosure, particularly in a manner not reasonably suggested by the specification, drawings, or original claims. It is of particular significance that appellant did not use the terminology "perfect" in the Detailed Description of the Present Invention to refer to printing on both sides of the substrate. Since the term "perfect" was used in column 2 lines 54 - 55 in the "Description of Related Art" it is dubious that appellant would use the term "over" to mean perfector printing in the remainder of the disclosure in reference to the instant invention.

It is even more important to note that some of the added claims have not generically referred to perfector printing (i.e. the broad concept that a substrate is printed on both sides), but rather very specifically recite which type of inks are printed on the first side by a particular process and which types of different inks are printed on the opposite side by a different process. Note claims 50, 53, 72, 81, 82, 85, 94, 100, 109, 119, 125, and 139 which recite that the second color is printed by lithography on the reverse side of the substrate from the first color which is printed by flexography. Further note claim 77 which recites that an ink is printed on the opposite side of an encapsulated essence in a slurry and claim 80 which recites printing a waterless ink on the reverse side of an ink or coating applied to the first side by flexography. Even if the disclosure that

many sheetfed presses of the prior art can perfector print entitles appellant to claim that which is conventional in the art, the above claims recite detailed steps that are well beyond that reasonably disclosed by appellant.

Second, the original declaration under 37 C.F.R. § 1.132 by Raymond Prince does not provide any objective evidence that the term "over" may also mean perfector printing. Although requested, declarant has not provided any commercial literature that states that the term "over" means to perfector print in the manner claimed by appellant. As stated by declarant in paragraph (1) the term "over" has been commonly used to refer to overprinting or trapping, i.e. printing "on top of" a previously applied layer. This is the only use of the term in the art that the examiner is aware of. Paragraph (2) then states that "over" describes printing on both sides of the substrate during one pass in a printing press. It is not apparent how the term "over" could be interpreted as such.

For example, note column 4 lines 32 - 38, column 5 lines 17 - 20, column 6 lines 1 - 5, and column 7 lines 15 - 18 which discloses applying an overcoating "over" the previously applied liquid vehicle image. It is clear from appellant's disclosure that an overcoating is applied "on top of" the previously applied liquid image since appellant defines in column 3 lines 18 - 22 that an overcoating is used to protect the previously applied layer (obviously the overcoating could not protect the previously applied liquid if the overcoating is applied on the opposite side of the substrate). Note also column 7 lines 24 - 33 which discloses drying the previously applied image before printing a color image "over" the vehicle image. According to column 4 line 52 through column 5 line 4 and column 6 lines 35 - 45 the purpose of the high speed dryer is to allow subsequent images to be printed on the previously applied images without causing smearing of the previously applied image at the subsequent station.

In view of the entirety of the disclosure, appellant's asserted meaning of the term "over" would appear to be repugnant, and in fact opposite, to its normal meaning. See M.P.E.P. 608.01(o). Even if the term "over" could be interpreted to mean perfector printing it is not at all apparent how one of ordinary skill in

the art could decipher the myriad instances of "over" throughout the disclosure to mean overprinting in one instance yet perfector printing in another instance.

Third, the declaration filed under 37 C.F.R. § 1.132 by the inventors Hartung, Jung, and Schneider merely provide a conclusory opinion without any factual or objective evidence. Opinion evidence as to a legal conclusion is not entitled to any weight lacking an underlying factual basis. M.P.E.P. § 716.01(c) Opinion Evidence. There is no underlying factual basis in this declaration. However, the opinion testimony has been carefully considered anyways. Paragraph (9) of the declaration sums the entire basis for the inventors' opinion. The first sentence alleges that the disclosure "reasonably conveys to one skilled in the relevant art that the inventors had possession of the claimed invention as it relates to perfector printing". Such a statement is devoid of any factual basis that could possibly support a reasoned opinion. The second sentence states "we believe that disclosure of a continuous in-line process necessarily implies perfector printing" which at least provides some basis from appellant's disclosure for the declarants' opinion. This theory rests apparently upon the conclusion that a "continuous in-line process" is a fully completed process lacking any subsequent processing of the substrate. However, this assumes that the substrate *must* be printed on both sides in order to be complete. While a large portion of commercial substrates are printed on both sides it is not necessarily so. Furthermore, in the context of appellant's disclosure, the continuous in-line process most likely refers to the fact that both lithographic and flexographic printing are accomplished in one pass, not that first and second sides of the substrate are printed in one pass. See column 3 lines 40 - 52 in appellant's disclosure. In other words, the gist of appellant's invention is that lithographic and flexographic printing are accomplished in a continuous in-line process without having to refeed the substrate through a second and different type of printing press (e.g. one of a lithographic press or flexographic press).

In conclusion, appellant has failed to rebut the examiner's *prima facie* case of lack of enablement as the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where

necessary, that one skilled in the art would have been able to make and use the claimed invention using the disclosure as a guide. M.P.E.P. § 716.09 Sufficiency of Disclosure. Affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite. *In re Buchner*, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991). Affidavits or declarations purporting to explain the disclosure or to interpret the disclosure are usually not considered. *In re Oppenauer*, 143 F.2d 974, 62 USPQ 297 (CCPA 1944).

Issues 3-16, 18-25, & 27-30

Appellant argues that 1) the examiner has failed to establish a prima facie case of obviousness, 2) the objective evidence in the declaration by inventors Hartung, Jung, and Schneider has not been countered by the examiner, and 3) the examiner has a) not identified within the references, the specific portions containing the teachings relied upon, b) the teaching or motivation to combine the references, or c) the expectation of success in making the combination.

The first argument is deemed to be encompassed by the third argument; if the examiner can identify within the references the specific portions relied upon, the motivation to combine, and the expectation of success then a prima facie case of obviousness is satisfied. The second argument is mere opinion evidence lacking any factual support other than a reiteration that the references lack the recited elements and the motivation to combine. Again, this argument is deemed to be encompassed by the third argument. If the elements of the third argument are satisfied then the declaration lacks persuasion.

Issues 3, 9, 15, & 19

Each of the above issues are drawn to the combination of MAN Roland with Pantone and Offsetpraxis. MAN Roland discloses in claims 1 and 6 a multicolored offset (i.e. lithographic) printing process having lithographic stations (1-5) and an upstream lacquering station configured as a flexographic station (6). Pantone teaches the desirability of printing/coating inks having suspended metallic particles

upstream of the other colors since the metallic inks are opaque and would thus block sight of any previously printed colors. Note, in particular, the paragraph headed "Color Sequence for MIPP". Offsetpraxis discloses the conventionality of a combined flexographic and lithographic printing process wherein the aqueous based inks having suspended metallic particles are printed by flexography and the remaining colors are printed by lithography. Note that Offsetpraxis specifically teaches the desirability of applying the metallic ink by flexography (significantly more ink can be applied). See the entire document of Offsetpraxis, in particular, the middle column of page 2 of the translation and the third column of page 3 of the translation.

From these teachings it is clear that the references disclose each of the recited elements of claim 6. The motivation to combine is apparent from both Pantone and, in particular, Offsetpraxis. In a combined lithographic and flexographic printing press (such as the one disclosed by MAN Roland), Offsetpraxis specifically teaches printing metallic particles in aqueous solution by flexography and the colored inks by lithography. Pantone specifically teaches that the metallic inks must be printed before the lithographic inks. Lastly, the expectation of success is apparent from the motivation to combine. In other words, when metallic inks are printed before colored inks then the metallic inks do not block the colored inks (Pantone) and a hybrid machine (Offsetpraxis) allows significantly more metallic ink to be applied by flexography while also allowing colored inks to be applied by lithography.

Issues 4, 12, 13, 23, & 28

Each of the above issues are drawn to the reference to Bird. Bird specifically teaches that a printing unit may be modified "intermittently" to be either a lithographic printing station (for printing colored inks) or a flexographic station for applying coatings. See, in particular, column 6 lines 6 - 20 of Bird. Note that the plate cylinder then either mounts a lithographic plate or a flexographic (i.e. relief) printing plate. Accordingly, Bird teaches the recited elements. The motivation to intermittently modify the unit allows the

flexibility to adapt the printing press to different requirements. The expectation of success is to save money by having an adaptable printing press.

Issues 5, 11, 12, 18, 29, & 30

Each of the above issues are drawn to the reference to Schone et al. Schone et al. clearly teach perfecter printing, and more importantly the specific structure to carry it out, in column 1 lines 11 - 32 and column 5 lines 56 - 64. The motivation to combine and the expectation of success are self evident; to have a substrate printed on both sides in one pass through the printing press.

Issue 6

Claim 4 of MAN Roland arguably discloses a flexographic plate having an image. However, Satterwhite teaches a flexographic unit for either coating or printing a flexographic image. See the Abstract and column 2 line 40 through column 3 line 10 of Satterwhite. To provide the unit of MAN Roland with a flexographic plate having an image in view of Satterwhite would allow either a coating or a colored to be applied in image form. The motivation to combine and expectation of success is evident from the teaching in column 3 lines 6 - 10 of Satterwhite which states that a smaller capital investment allows the unit to function as both a coater and an ink printer.

Issues 7 & 13

Each of the above issues are drawn to the reference to Bird with respect to interstation dryers. Bird teaches the desirability of interstation dryers (25, 25a) in column 3 lines 12 - 25 and the paragraph bridging columns 6 and 7. The motivation to combine and expectation of success is evident from the teachings of Bird to eliminate smearing of the previously printed inks.

Issues 8, 10, 14, 21, 22, & 24

Each of the above issues are drawn to the reference to Schumacher et al. Schumacher et al. teach the conventionality of a coating apparatus for printing an encapsulated essence in column 1 lines 29 - 31.

The motivation and expectation of success would be to provide "scratch-and-sniff" essences on a printed substrate.

Issues 16 & 20

Each of the above issues are drawn to the reference to Roulleau. Roulleau teaches the desirability of printing an opaque white ink by flexography in column 3 lines 61 - 68 to provide a background for additional colors of ink. The motivation and expectation of success would be to provide a white background so as to provide sufficient contrast for subsequently printed colors on a non-white substrate.

Issue 25

Appellant's statement that Hartung et al. does not teach the apparatus and method as recited is not convincing in lack of any specific reasons to the contrary. Note, in particular, column 2 lines 12 - 22 and 38 - 50 and column 5 line 56 through column 6 line 10 for the recited elements.

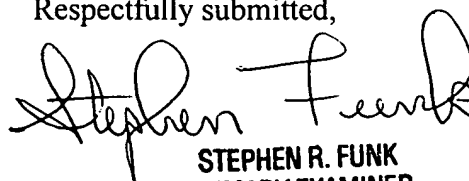
Issue 27

With respect to claims 7, 8, 32, 33, 47 - 49, and 51 Hartung et al. admittedly do not disclose that the metallic particles are uniform or non-uniform. However, to provide uniform or non-uniform sized particles would have been obvious to one of ordinary skill in the art through routine experimentation to achieve the desired metallic look on the printed substrate. Both waterless (dry lithography) and solvent based (wet lithography) inks and web and sheet substrates are so notoriously conventional in the art as to have been obvious to one of ordinary skill in the art.

(14) Conclusion

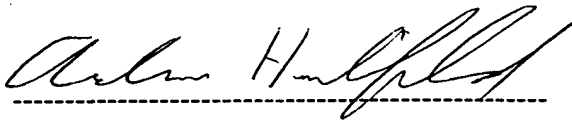
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


STEPHEN R. FUNK
PRIMARY EXAMINER


December 6, 2001

Conferees

 11/15/02

Drew Hirshfeld, SPE AU 2854

NOTED "9/25/04" 9/25/04



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APPENDIX

19. Apparatus as in claim 17 wherein at least one of the said colored ink images [are] is formed with a waterless [inks] ink.

20. Apparatus as in claim 17 further including an air dryer adjacent to said impression cylinder for drying the colored flexographic ink image transferred to said substrate before said additional colored ink images are printed thereon.

22. Apparatus as in claim 17 wherein said colored flexographic ink image and said lithographic colored ink images are printed as solid colors and/or with halftone printing plates in sequence and in registry in said successive printing stations to produce said multicolored image on said substrate.

29. A method of combining lithography and flexographic printing in a continuous in-line process comprising the steps of:

providing a plurality of successive lithographic/flexographic printing stations for printing colored ink images on a substrate;

printing a flexographic ink image on said substrate at at least one of said flexographic stations;

transferring said printed substrate to at least one subsequent printing station in said continuous in-line process; and

printing colored ink images [on top of] over said flexographic ink image at at least one of said subsequent lithographic printing stations with an offset lithographic process.

34. A method as in claim 29 further including the steps of:

printing a slurry on said substrate at any of said printing stations in said continuous in-line process;

using an encapsulated essence in said slurry; and

printing an overcoating [over] on top of said slurry at a subsequent printing station in said in-line process to protect said essence.